

Patent Application
U.S. Application No.: 10/777,634
Attorney Docket No.: 52493.000368

REMARKS

The Office Action has been received and carefully considered. Claims 1-8, 10, 12-16, 18 and 19 are pending. Claims 18 and 19 are amended.

No new matter is added.

Reconsideration of the outstanding rejections in the present application are requested based on the following remarks.¹

A. The 35 U.S.C. 101 Rejection

In the Office Action, claims 18 and 19 are rejected under 35 U.S.C. 101. The Office Action asserts the claimed invention is directed to non-statutory subject matter. The Office Action sets forth asserted basis for the 35 U.S.C. 101 rejection.

In order to expedite prosecution of the present application, the rejected claims are canceled or amended to more clearly recite statutory subject matter under 35 U.S.C. 101.

Specifically, claim 18 is amended to recite a "non-transitory computer-readable medium". Further, Applicant previously amended the last clause in each of claims 18 and 19 to recite such non-transitory limitation.

Applicant respectfully submits that the claims satisfy 35 U.S.C. 101, and requests that the rejection be withdrawn.

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

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B. The Rejection under 35 U.S.C. § 102

In the Office Action, claims 1, 3-8, 12, 14-16 and 18-19 stand rejected under 35 U.S.C. § 102 as being unpatentable over U.S. Patent 5,235,654 to Anderson *et al.* ("Anderson"). This rejection is traversed.

Applicant respectfully submits that the present rejection fails to articulate sufficient findings of fact to support the 35 U.S.C. 102 rejection, in particular as to the amended claims. Applicant respectfully requests that the rejection under 35 U.S.C. 102 be withdrawn.

Applicant's basis for such traversal is set forth below.

The features of claim 1 are set forth in the listing of claims above. In particular, claim 1 as previously recites:

rules engine configured to generate an exception task if it is determined that at least one data element is not clean, the rules engine generates an exception task constituted by the rules engine determining a process that is to be performed on one data element of the at least one data element that is not clean, **the exception task associated exclusively to the one data element so as to process the one data element as an individual data element**, and the rules engine generating the exception task being performed in conjunction with the rules engine **performing a determination of whether the one data element that is not clean is due to (a) more information being required, or (b) the one data element itself is problematic; and**

the rules engine configured to receive a resolution for the one data element to the exception task for the one data element, upon the performance of the determined process, thereby enabling validation of the at least one data element.

(emphasis added)

Claim 1 further recites:

... the rules engine generates an exception task constituted by the rules engine determining a process that is to be performed on one data element of the at least one data element that is not clean, **the exception task associated exclusively to the one data element so as to process the one data element as an individual data element;**

(emphasis added)

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Accordingly, claim 1 recites the one-to-one relationship of the exception task, as well as the one-to-one relationship of the exception task vis-à-vis the claimed "resolution."

In Applicant's August 1, 2011 Response, claim 1 was further amended to recite:

... and the rules engine generating the exception task being performed in conjunction with the rules engine **performing a determination** of whether the one data element that is not clean due to (a) more information being required, or (b) the one data itself is problematic; ...

(emphasis added)

Applicant submits that the applied art fails to teach such particular processing. Such claimed features further relate to the nature of the processing of the claimed invention, and further distinguish over the teachings of Anderson.

Under 35 U.S.C. §102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Id.* "A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, *every limitation of the claim.*" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The *identical invention* must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226 (Fed. Cir. 1989). "Absence from the reference of *any* claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

On pages 4-5, the Office Action sets forth various alleged features of Anderson. In particular, in paragraph (g) on page 5 lines 9-13, the Office Action asserts:

g. the advance data capture system generating an error correction process being performed in conjunction with the data capture system **performing a**

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determination of whether the one character that is not correct is due to the one character itself being problematic (Anderson, col. 21 lines 10-15, col. 33 lines 8-22).

(emphasis added)

Based on Applicant's review, it appears that such assertions are directed to the newly added features in Applicant's claimed invention, set forth above. Specifically, such features of claim 1 recite:

... and the rules engine generating the exception task being performed in conjunction with the rules engine **performing a determination** of whether the one data element that is not clean due to (a) more information being required, or (b) the one data itself is problematic; ...

(emphasis added)

Applicant submits that such assertions of the Office Action fail to address Applicant's claimed features, even if such assertions of the Office Action are admitted as true, which Applicant does not admit. That is, claim 1 recites performing a determination as to a one data element that is not clean. Specifically, claim 1 recites two prongs to the determination, i.e., whether the one data element that is not clean due to (a) more information being required, or (b) the one data itself is problematic. Applicant submits that the phrasing of such language in claim 1 precludes an "either or" interpretation. That is, Applicant submits that to fairly teach such feature of claim 1, Anderson must disclose processing that performs a determination of whether that one data element is not clean due to (a) or (b), as recited. Applicant submits that Anderson fails to teach such claimed two prong analysis.

In the referenced col. 21 lines 10-15, Anderson describes:

... The form return code parameter will indicate if errors were encountered when processing the image. If the return code indicates errors existed at the field level, the rejected character and suspicious character return codes must be checked to determine the exact error. ...

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(emphasis added)

Applicant submits that such disclosure of Anderson fails to teach the particulars of the claimed two prong analysis. And as noted above, Applicant submits that the Office Action fails to even allege such, i.e., see Office Action in paragraph (g), page 5.

Further, Applicant submits that the referenced column 33, lines 8-22, of Anderson also fails to teach the claimed features. Therein, Anderson teaches:

... A copy of the document image 10' will be delivered over the LAN 20 to the correction processor 32, for viewing by the operator. The location specified by the coordinates of the rejected or suspicious character are used to highlight and/or magnify that portion of the document image displayed. **The operator can then quickly compare the highlighted portion of the document image to the character string 48 "John," which is also displayed in alphanumeric characters on the display screen of the processor 32. If the operator accepts the representation of the string 48 "John," then a validation acceptance is recorded in the segment R3. The validation indication can be entered into the segment R3, for example under the comments portion.**

(emphasis added)

Applicant submits that such disclosure of Anderson is even less material than Anderson's relied upon column 21 teaching, discussed above. Indeed such teaching focuses on what appears to be human operator interaction with the processor. Relatedly, Applicant notes Anderson at column 7, lines 21-31. Such teachings of Anderson are in sharp contrast to Applicant's claimed two prong analysis, as set forth in claim 1.

Withdrawal of the 35 U.S.C. 102 rejection is requested.

For at least the reasons set forth above, Applicant submits that Anderson fails to support the applied rejection of claim 1 under 35 U.S.C. 102.

Regarding independent claims 10, 12, 18, and 19, since these claims contain similar limitations as argued above with respect to independent claim 1, the same reasons apply to these independent claims.

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For at least these reasons, independent claims 1, 10, 12, 18, and 19, as well as the various dependent claims are patentable over the applied art. Therefore, the undersigned representative will not address the arguments with respect to such dependent claims and reserves the right to address these arguments at a later time. Accordingly, it is respectfully requested that the rejection of claims 1, 3-8, 12, 14-16 and 18-19 under 35 U.S.C. §103 be reconsidered and withdrawn.

C. The Rejection under 35 U.S.C. § 103

In the Office Action, claims 2, 10 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of in view of Scanlon (US 5,850,480) in further view of the Office Action's alleged Applicant Admitted Prior Art (AAPA).

As referenced in the Office Action and as set forth in M.P.E.P. 706.02(j), 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. M.P.E.P. 706.02(j) indicates that after indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth in the Office Action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P. 706.02(j) references the well known requirements of *Graham v. John Deere*.

Further, M.P.E.P. 706.02(j) notes that it is important for an Examiner to properly communicate

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the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply.

Applicant submits that the modification of Anderson, as proposed in the Office Action, fails to cure the deficiencies of the rejection, as discussed above. That is, Applicant submits that even if it were obvious to modify Anderson as asserted in the rejection of claims 2, 10 and 13 under 35 U.S.C. 103, which is not admitted by Applicant, such would still fail to fairly teach or suggest the claimed invention.

In its interpretation, the Office Action appears to cast both Anderson and Scanlon as teaching the recited "data element." As best understood, the Action appears to be attempting to interpret Anderson's "character" or "character position" as the claimed "data element." (see Anderson in column 7, lines 1-4 and the pending Office Action on page 5, lines 6-8). On the other hand, as best understood, the Office Action (page appears to be attempting to interpret Scanlon's "sub-string table" as the claimed "data element." (see Scanlon in column 31, lines 42-48 and column 33, lines 16-31).

Applicant respectfully submits that such parameters of Anderson vis-à-vis Scanlon are fundamentally different in nature. Applicant submits that it is unworkable to interpret such parameters as constituting the claimed data element, or being somehow akin to each other. Indeed, it is fully unclear how the described manipulation of Anderson's "character" or "character position" would be combined with the described manipulation of Scanlon's "sub-string table", i.e., so as to be workable in any manner. Indeed, Applicant submits that to talk of such respective parameters of Anderson and Scanlon as akin (to each other), and thus combinable as alleged in the Office Action, is not fairly supported.

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As articulated in the Federal Register guidelines:

Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed. Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office Action leads to the prompt resolution of issues pertinent to patentability. Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* Federal Register vol. 72, No. 195, Wednesday, October 10, 2007, page 57527.

Independent claim 10 is allowable for reasons similar to those reasons set forth above regarding claim 1. Further, since claims 2 and 13 are respectively dependent on allowable claims 1 or 12, these claims are allowable for the same reasons. Accordingly, it is respectfully requested that the rejection of claims 2, 10 and 13 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Withdrawal of the 35 U.S.C. 103 rejection is requested.

D. Conclusion

For at least the reasons outlined above, Applicant respectfully asserts that the application is in condition for allowance. Favorable reconsideration and allowance of the claims are respectfully solicited.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

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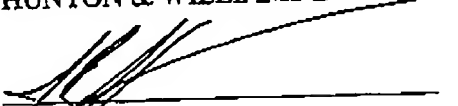
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For any fees due in connection with filing this Response the Commissioner is hereby
authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: January 30, 2012


James R. Miner
Registration No. 40,444

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
2200 Pennsylvania Ave NW
Washington, D.C. 20037-1701
Phone (202) 955-1500
Facsimile (202) 778-2201